**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In Re Application of: ) | |
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| Farrell, et al. ) | Confirmation No. 6276 |
| ) | |
| Serial No.: 10/721, 703 ) | Examiner: Garcia, Gabriel I. |
| ) | Group Art Unit: 2625 |
| Filed: November 25, 2003 ) | |
| ) | |
| For: **Image Forming Device with Print Mode** ) | HP Docket No.: 200209668-1 |
| **Actuator and Method** ) | |
| ) | |

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed herewith, responding

to the final Office Action mailed April 29, 2009

**REAL PARTY IN INTEREST**

The real party in interest of the instant application is Hewlett-Packard Development

Company, a Texas Limited Liability Partnership having its principal place of business in

Houston, Texas.

**I. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**II. STATUS OF THE CLAIMS**

Claims 1-29 are pending in this application. Claims 1-4, 9-12, 16-20 and 24-29 were

rejected by the final Office Action, and are the subject of this appeal. Claims 5-8, 13-15, and

21-23 were objected to by the final Office Action, as the final Office Action stated that the claims

would be allowable if re-written in independent form.

## III. STATUS OF AMENDMENTS

There have been no claim amendments made after the final Office Action, and all amendments made before the final Office Action have been entered. The claim listing in section VIII (CLAIMS – APPENDIX) represents the present state of the claims.

## IV. SUMMARY OF THE CLAIMED SUBJECT MATTER

Embodiments of the claimed subject matter are summarized below with reference numbers and references to the written description ("specification") and drawings. The subject matter described below appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure. Embodiments according to independent claim 1 involve a method (p. 10, lines 9-13; FIG. 3: 260), comprising: receiving a document for printing in an image forming device (p. 10, lines 21-22; FIG. 3: 302), wherein a print mode setting is associated with the document (p. 10, lines 2-4; FIG. 3: 304); and printing at least a portion of the document monochromatically (p. 10, lines 24-30; FIG. 3: 306, 308) or in color based upon the print mode setting (p. 10, lines 24-30; FIG. 3: 306, 308, 310) and a state of a print mode actuator in the image forming device (p. 11, lines 5-29; FIG. 3: 310, 312, 318), where the print mode actuator includes at least an application state and a monochromatic override state (p. 11, line 20 – p. 12, line 26: FIG. 3: 312).

Embodiments according to independent claim 9 involve a program embodied in a computer readable medium (p. 6, lines 21-31; FIG. 2: 212, 214), comprising code that identifies a print mode setting (p. 8, lines 6-9; FIG. 2: 260) associated with a document received for printing in an image forming device (p. 8, lines 6-9; FIG. 2: 260); and code that implements a printing of at least a portion of the document monochromatically or in color based upon the print mode setting (p. 8, line 10 – p. 9, line27; FIG. 2: 260) and a state of a print mode actuator in the

image forming device (p. 9, line 1-27; FIG. 2: 260), where the print mode actuator includes at least an application state and a monochromatic override state (p. 9, lines 12-27; FIG. 2: 216, 132, 260).

Embodiments according to independent claim 16 involve an image forming device (p. 1, lines 1-10; FIG. 1: 100), comprising: a print mode actuator disposed on the image forming device (p. 3, lines 10-21; FIG. 1: 132) having a first state and a second state (p. 3, lines 10-21; FIG. 1: 132), where the first state is an application state and the second state is a monochromatic override state (p. 3, lines 10-26; FIG. 1: 132); and a print engine (p. 5, lines 15-34; FIG. 2: 214) configured to implement a printing of at least a portion of a document monochromatically or in color based upon a print mode setting associated with the document (p. 8, line 10 – p. 9, line27; FIG. 2: 260) and based upon a state of the print mode actuator in the image forming (p. 9, lines 12-27; FIG. 2: 216, 132, 260).

Embodiments according to independent claim 24 describe an image forming device device (p. 1, lines 1-10; FIG. 1: 100), comprising: means for identifying (FIG. 2: 220, 260) a print mode setting associated with a document received for printing in an image forming device (p. 10, lines 22-24; FIG. 1, 100), and means for implementing (FIG. 2: 220, 222, 252, 260) a printing of at least a portion of a document monochromatically or in color based upon the print mode setting and a state of a print mode actuator (FIG 1: 132) in the image forming device (p. 11, lines 5-19; FIG. 1: 100), where the print mode actuator includes at least an application state and a monochromatic override state (p. 9, lines 12-27; FIG. 2: 216, 132, 260).

Embodiments according to independent claim 27 describe a method (p. 10, lines 9-13; FIG. 3: 260) comprising determining a state of a print mode actuator (FIG. 1: 132), the print mode actuator (FIG. 1: 132) having at least an application state and a black override state (p. 6, lines 12-15 and lines 22-23); executing a color raster image processing of a document if the

print mode actuator (FIG. 1, 132) is in the application state and the document includes a color print setting (p. 9, lines 12-15).

## V. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal.

A. Claims 1-4, 9-12, 16-20 and 24-29 have been rejected under 35 U.S.C. 102(e) as being anticipated by *Tyson, et al.*

## VI. ARGUMENT

### *A.* Rejection of claims 1-4, 9-12, 16-20 and 24-29 under 35 U.S.C. §102(e): *Tyson*

Appellant submits that the rejection of claims 1-4, 9-12, 16-20 and 24-29 should be overturned because *Tyson* does not disclose, teach, or suggest every element of these claims. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g.*, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the amended claims is represented in the *Tyson* reference.

## 1. Claims 1-4

Claim 1 (with emphasis added) recites:

1.    A method, comprising:
   receiving a document for printing in an image forming device, wherein a print mode setting is associated with the document; and
   printing at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where **the print mode actuator includes at least an application state and a monochromatic override state**.

Appellants respectfully submit that independent claim 1 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 1.

Further, the Office Action alleges on pages 2-3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in claim 1.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 1. Therefore, Appellants respectfully submit that the rejection of claim 1 be overturned. Since independent claim 1 is allowable, Appellants respectfully submit that (in addition to allowed claims 5-8) claims 2-4 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988) Therefore, Appellants respectfully request that the rejection of claims 2-4 be overturned.

## 2. Claims 9-12

Claim 9 (with emphasis added) recites:

> 9.  A program embodied in a computer readable medium, comprising:
> code that identifies a print mode setting associated with a document received for printing in an image forming device; and
> code that implements a printing of at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where **the print mode actuator includes at least an application state and a monochromatic override state**.

Appellants respectfully submit that independent claim 9 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 9. Further, the Office Action alleges on pages 2-3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in amended claim 9.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 9. Therefore, Appellants respectfully submit that the rejection of claim 9 be overturned. Since independent claim 9 is allowable, Appellants respectfully submit that (in addition to allowed claims 13-15) claims 10-12 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Appellants respectfully request that the rejection of claims 10-12 be overturned.

### 3. Claims 16-19

Independent claim 16 (with emphasis added) recites:

16.    An image forming device, comprising:
       *a print mode actuator* disposed on the image forming device *having a first state and a second state, where the first state is an application state and the second state is a monochromatic override state*; and
       a print engine configured to implement a printing of at least a portion of a document monochromatically or in color based upon a print mode setting associated with the document and based upon a state of the print mode actuator in the image forming.

Appellants respectfully submit that independent claim 16 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 16. Further, the Office Action alleges on pages 2-3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "a print mode actuator … having a first state and a second state, where the first state is an application state and the second state is a monochromatic override state" as recited in amended claim 16.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 16. Therefore, Appellants respectfully submit that the rejection of claim 16 be overturned. Since independent claim 16 is allowable, Appellants respectfully submit that (in addition to allowed claims 21-23) claims 17-19 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Appellants respectfully request that the rejection of claims 17-19 be overturned.

### 4. Claim 20

Since independent claim 16 is allowable, Appellants respectfully submit that (in addition to allowed claims 21-23) claim 20 is allowable for at least the reason that it depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Appellants respectfully request that the rejection of claim 20 be overturned.

In addition to the arguments set forth above with respect to independent claim 16, Appellants respectfully request that the rejection of claim 20 be overturned for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 20. Appellants' claim 20 (with emphasis added) recites:

> 20.    The image forming device of claim 16, ***the print engine is further configured to detect a change in the state of the print mode actuator during an execution of a raster image processing of the document***, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

The Office Action fails to even allege that the cited art discloses detect[ing] a change in state of the print mode actuator, as recited by claim 20. The previous Office Action mailed November 17, 2008 alleges that "Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*])..." (*Emphasis in original*). Appellants' submit that these allegations are absent from the final Office Action and that the final Office Action fails to address the specific limitations of claim 20 in any fashion.

However, with respect to the allegations of the previous Office Action, Appellants respectfully disagree. Appellants respectfully submit that detecting a switch between modes is not the same as "detect[ing] a change in the state of the print mode actuator". While *Tyson* states the following in claim 3:

> A printer, comprising:
>     means for tracking a wear level of a color cartridge based on activity
> in color mode;
>     means for tracking a consumable use level of the color cartridge

based on color consumables expended;
    projecting a color cartridge failure mechanism to be either color
cartridge wear-out or consumable exhaustion based on the wear level
and the consumable use level; and
    means for switching between color mode and monochrome mode to
decrease likelihood of color cartridge wear-out before color consumables
are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detect[ing] a change in the state of the

print mode actuator", much less "detect[ing] a change in the state of the print mode actuator

during an execution of a raster image processing of the document". *Tyson* does not even

mention raster image processing. As is well established in the law, the Examiner must instead

consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir.

2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate

under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of

the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*,

Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest

"the print engine is further configured to detect a change in the state of the print mode actuator

during an execution of a raster image processing of the document" as recited in claim 20.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the

features recited in claim 20. Therefore, Appellants respectfully submit that the rejection of claim

20 be overturned.

## 5. Claim 24

Claim 24 (with emphasis added) recites:

    24.    An image forming device, comprising:
        means for identifying a print mode setting associated with a document
    received for printing in an image forming device; and
        means for implementing a printing of at least a portion of a document
    monochromatically or in color based upon the print mode setting and a state
    of a print mode actuator in the image forming device, where ***the print mode
    actuator includes at least an application state and a monochromatic
    override state***.

Appellants respectfully submit that independent claim 24 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 24.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in claim 24.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 24. Therefore, Appellants respectfully submit that the rejection of claim 24 be overturned.

### 6. Claims 25-26

Since independent claim 24 is allowable, Appellants respectfully submit that claims 25-26 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Appellants respectfully request that the rejection of claims 25-26 be overturned.

#### a. Claim 25

Notwithstanding, and in addition to, the arguments discussed above, Appellants respectfully request that the rejection of claim 25 be overturned for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 25. Claim 25 (with emphasis added) recites:

25.    The image forming device of claim 24, further comprising **means for detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document**, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

Appellants submit that the final Office Action fails to address in any way the above emphasized limitations of claim 25.  The previous Office Action mailed November 17, 2008 alleges on pages 4-5 that "Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*])..." (emphasis in original).  Appellants respectfully disagree.  Appellants' submit that these allegations are absent from the final Office Action and that the final Office Action fails to address the specific limitations of claim 25 in any fashion.  However, with respect to the allegations of the previous Office Action, Appellants respectfully submit that detecting a switch between modes is not the same as "detecting a change in the state of the print mode actuator".  While *Tyson* states in claim 3:

> A printer, comprising:
>     means for tracking a wear level of a color cartridge based on activity in color mode;
>     means for tracking a consumable use level of the color cartridge based on color consumables expended;
>     projecting a color cartridge failure mechanism to be either color cartridge wear-out or consumable exhaustion based on the wear level and the consumable use level; and
>     means for switching between color mode and monochrome mode to decrease likelihood of color cartridge wear-out before color consumables are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detecting a change in the state of the print mode actuator", much less "detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document".  *Tyson* does not even mention raster image processing.  As is well established in the law, the Examiner must instead consider the claims as a whole.  *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate

under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "means for detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document" as recited in claim 25.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 25. Therefore, Appellants respectfully submit that the rejection of claim 25 be overturned.

### b. Claim 26

Notwithstanding, and in addition to, the arguments discussed above, Appellants respectfully request that the rejection of claim 26 be overturned for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 26. Claim 26 (with emphasis added) recites:

> 26.     The image forming device of claim 25, further comprising ***means for implementing a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator***.

Appellants submit that the final Office Action fails to address in any way the above emphasized limitations of claim 25. The previous Office Action mailed November 18, 2008 alleged on pages 4-5 that

> Tyson et al further teaches … transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

Appellants' submit that these allegations are absent from the final Office Action and that the final Office Action fails to address the specific limitations of claim 26 in any fashion. However, with respect to the allegations of the previous Office Action, Appellants respectfully disagree. Appellants submit that *Tyson* does not even mention raster image processing. *Tyson* also fails to

teach or suggest "implementing a transition of the raster image processing of the document at a transition point". As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Accordingly, *Tyson* does not disclose or suggest "means for implementing a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 26.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 26. Therefore, Appellants respectfully submit that the rejection of claim 26 be overturned.


### 7. Claim 27

Claim 27 (with emphasis added) recites:

> 27.     A method, comprising:
>         determining a state of a print mode actuator, **the print mode actuator having at least an application state and a black override state**; and
>         executing a color raster image processing of a document if the print mode actuator is in the application state and the document includes a color print setting.

Appellants respectfully submit that independent claim 27 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 27.

Further, the final Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be

used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator having at least an application state and a black override state" as recited in amended claim 27.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 27. Therefore, Appellants respectfully submit that the rejection of claim 27 be overturned.


### 8. Claims 28-29

Since independent claim 27 is allowable, Appellants respectfully submit that claims 28-29 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Appellants respectfully request that the rejection of claims 28-29 be overturned.

### a. Claim 29

Notwithstanding, and in addition to, the arguments discussed above, Appellants respectfully request that the rejection of claim 29 be overturned for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited in claim 29. Claim 29 (with emphasis added) recites:

> 29. The method of claim 28, further comprising:
> *detecting a change of the print mode actuator during one of the executing the black raster image processing and the executing the color raster image processing of the document*; and
> *transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a transition point in response to the change in the state of the print mode actuator*.

Appellants submit that the final Office Action fails to address in any way the above emphasized limitations of claim 25. The previous Office Action mailed November 17, 2008 alleges on pages 4-5 that

Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*]); and transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

(Emphasis in original). Appellants' submit that these allegations are absent from the final Office Action and that the final Office Action fails to address the specific limitations of claim 29 in any fashion. However, with respect to the allegations of the previous Office Action, Appellants respectfully disagree. Appellants respectfully submit that detecting a switch between modes is not the same as "detecting a change of the print mode actuator". Further, while *Tyson* states in claim 3:

A printer, comprising:
 means for tracking a wear level of a color cartridge based on activity
in color mode;
 means for tracking a consumable use level of the color cartridge
based on color consumables expended;
 projecting a color cartridge failure mechanism to be either color
cartridge wear-out or consumable exhaustion based on the wear level
and the consumable use level; and
 means for switching between color mode and monochrome mode to
decrease likelihood of color cartridge wear-out before color consumables
are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detecting a change of the print mode actuator", much less "detecting a change of the print mode actuator <u>during one of the executing</u> <u>the black raster image processing and the executing the color raster image processing of the</u> <u>document</u>". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus,

*Tyson* does not disclose or suggest "detecting a change of the print mode actuator during one of the executing the black raster image processing and the executing the color raster image processing of the document" as recited in claim 29.

*Tyson* also fails to teach or suggest "transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a transition point". Accordingly, *Tyson* does not disclose or suggest "transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 29.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 29. Therefore, Appellants respectfully submit that the rejection of claim 29 be overturned.

## VII. CONCLUSION

For at least the reasons discussed above, Appellants respectfully request that the Examiner's final rejection of claims 1-4, 9-12, 16-20 and 24-29 be overturned by the Board. In addition to the claims listed in Section VIII (CLAIMS – APPENDIX), Section IX (EVIDENCE – APPENDIX) included herein indicates that there is no additional evidence relied upon by this brief. Section X (RELATED PROCEEDINGS – APPENDIX) included herein indicates that there are no related proceedings.

Respectfully submitted,

By: _____/arr/_____

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## VIII. CLAIMS – APPENDIX

1.      A method, comprising:

receiving a document for printing in an image forming device, wherein a print mode setting is associated with the document; and

printing at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where the print mode actuator includes at least an application state and a monochromatic override state.

2.      The method of claim 1, wherein the printing of the at least a portion of the document further comprises implementing an execution of a monochromatic raster image processing of the document if the print mode setting specifies a monochromatic print setting.

3.      The method of claim 1, wherein the printing of the at least a portion of the document further comprises implementing an execution of a color raster image processing of the document if the print mode actuator is in the application state and the print mode setting specifies a color print setting.

4.      The method of claim 1, wherein the printing of the at least a portion of the document further comprises implementing an execution of a monochromatic raster image processing of the document if the print mode actuator is in the monochromatic override state and the print mode setting specifies a color print setting, thereby overriding the color print setting in the document.

5.      The method of claim 1, further comprising:

implementing an execution of a raster image processing of the document, wherein the raster image processing is of one of a monochromatic raster image processing or a color raster image processing;

detecting a change in the state of the print mode actuator during the execution of the raster image processing of the document; and

transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.

6.      The method of claim 5, wherein the transitioning is upon completion of the monochromatic or color raster image processing of a strip of the document that was in progress at the time of the change in the state of the print mode actuator.

7.      The method of claim 5, wherein the transitioning is upon completion of the monochromatic or color raster image processing of a page of the document that was in progress at the time of the change in the state of the print mode actuator.

8.     The method of claim 1, further comprising:

executing one of a monochromatic raster image processing or a color raster image processing of the document;

detecting a change in the state of the print mode actuator during the execution of the one of the monochromatic raster image processing or the color raster image processing of the document; and

completing the monochromatic raster image processing or the color raster image processing of the document even though a change in the state of the print mode actuator is detected that results in an inconsistency between the state of the print mode actuator and the raster image processing of the document that was in progress at the time of the change in the state of the print mode actuator.

9.     A program embodied in a computer readable medium, comprising:

code that identifies a print mode setting associated with a document received for printing in an image forming device; and

code that implements a printing of at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where the print mode actuator includes at least an application state and a monochromatic override state.

10.     The program embodied in the computer readable medium of claim 9, wherein code that implements the printing of the at least a portion of the document further comprises code that implements an execution of a monochromatic raster image processing of the document if the print mode setting specifies a monochromatic print setting.

11. The program embodied in the computer readable medium of claim 9, wherein the code that implements the printing of the at least a portion of the document further comprises code that implements an execution of a color raster image processing of the document if the print mode actuator is in the application state and the print mode setting specifies a color print setting.

12. The program embodied in the computer readable medium of claim 9, wherein the code that implements the printing of the at least a portion of the document further comprises code that implements an execution of a monochromatic raster image processing of the document if the print mode actuator is in the monochromatic override state and the print mode setting specifies a color print setting, thereby overriding the color print setting in the document.

13. The program embodied in the computer readable medium of claim 9, further comprising:

code that implements an execution of a raster image processing of the document, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing;

code that detects a change in the state of the print mode actuator during the execution of the raster image processing of the document; and

code that transitions the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.

14. The program embodied in the computer readable medium of claim 13, wherein the code that transitions further comprises code that implements the transition upon completion of the monochromatic or color raster image processing of a strip of the document that was in progress at the time of the change in the state of the print mode actuator.

15.     The program embodied in the computer readable medium of claim 13, wherein the code that transitions further comprises code that implements the transition upon completion of the monochromatic or color raster image processing of a page of the document that was in progress at the time of the change in the state of the print mode actuator.

16.     An image forming device, comprising:

a print mode actuator disposed on the image forming device having a first state and a second state, where the first state is an application state and the second state is a monochromatic override state; and

a print engine configured to implement a printing of at least a portion of a document monochromatically or in color based upon a print mode setting associated with the document and based upon a state of the print mode actuator in the image forming.

17.     The image forming device of claim 16, wherein print engine is further configured to implement an execution a monochromatic raster image processing of the document if the print mode setting specifies a monochromatic print setting.

18.     The image forming device of claim 16, wherein the print engine is further configured to implement an execution of a color raster image processing of the document if the print mode actuator is in the application state and the print mode setting specifies a color print setting.

19.     The image forming device of claim 16, wherein the print engine is further configured to implement an execution of a monochromatic raster image processing of the document if the print mode actuator is in the monochromatic override state and the print mode setting specifies a color print setting, thereby overriding the color print setting in the document.

20.     The image forming device of claim 16, the print engine is further configured to detect a change in the state of the print mode actuator during an execution of a raster image processing of the document, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

21.     The image forming device of claim 20, the print engine is further configured to implement a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.

22.     The image forming device of claim 21, wherein the print engine is further configured to implement the transition upon completion of the monochromatic or color raster image processing of a strip of the document that was in progress at the time of the change in the state of the print mode actuator.

23.     The image forming device of claim 21, wherein the print engine is further configured to implement the transition upon completion of the monochromatic or color raster image processing of a page of the document that was in progress at the time of the change in the state of the print mode actuator.

24.     An image forming device, comprising:

        means for identifying a print mode setting associated with a document received for printing in an image forming device; and

        means for implementing a printing of at least a portion of a document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where the print mode actuator includes at least an application state and a monochromatic override state.

25.     The image forming device of claim 24, further comprising means for detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

26.     The image forming device of claim 25, further comprising means for implementing a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.

27.     A method, comprising:

determining a state of a print mode actuator, the print mode actuator having at least an application state and a black override state; and

executing a color raster image processing of a document if the print mode actuator is in the application state and the document includes a color print setting.

28.     The method of claim 27, further comprising:

executing a black raster image processing of the document if the document includes a black print setting; and

executing a black raster image processing of a document if the print mode actuator is in the black override state and the document includes a color print setting, thereby overriding the color print setting in the document.

29.    The method of claim 28, further comprising:

detecting a change of the print mode actuator during one of the executing the black

raster image processing and the executing the color raster image processing of the document;

and

transitioning between the executing the black raster image processing and the executing

the color raster image processing of the document at a transition point in response to the

change in the state of the print mode actuator.

## IX. EVIDENCE – APPENDIX

None.

## X. RELATED PROCEEDINGS – APPENDIX

None.